

Response to Office Action of April 7, 2006  
Application Serial No.: 10/788,587  
Page 9

## REMARKS

### I. STATUS OF THE CLAIMS

Claims 1-22 are pending in the present application. In the Office Action mailed April 7, 2006, claims 1-22 were rejected.

By this Amendment, claims 1, 10, and 18 are amended. Please add claims 23-34. No new matter is presented. Please cancel claims 4 and 13.

### II. OBJECTION TO THE SPECIFICATION

In the Office Action, the specification was objected to for improperly using the word "our" instead of "or" on page 4, line 13. The specification is amended hereby. Thus, it is believed that this rejection is obviated and should be withdrawn.

### III. CLAIM REJECTIONS UNDER 35 U.S.C. §102(b) OR 35 U.S.C. §102(e)

Claims 1-7 are rejected under 35 U.S.C. §102(b) or (e) as being anticipated by U.S. Patent No. 6,270,093 to Johnson et al. ("*Johnson*"). Claims 2-7 depend directly or indirectly from claim 1. In view of the amendments to claim 1, it is believed that this rejection is obviated and should be withdrawn.

*Johnson* is directed generally to a nestable shopping cart for carrying multiple children. *Johnson* does not teach or suggest a nestable shopping cart formed to at least partially receive a second nestable shopping cart, where the nestable shopping cart includes a body comprising an integral seat portion and back portion, and where the back portion defines a nest space for receiving at least a portion of the second nestable shopping cart, as provided in amended claim 1. Instead, the inwardly-facing seats 40, 42 and backrests 44, 46 of *Johnson* define side walls of the seat module. The nesting space of *Johnson*, referred to as rear entrance 52, is instead defined by the seat module chassis 32, which includes a seat handle portion 38 (*see generally* col. 5, lines 20-32).

Given that *Johnson* fails to teach each and every element of amended claim 1, it is submitted that *Johnson* is insufficient to support a rejection of amended claim 1 or its

Response to Office Action of April 7, 2006  
Application Serial No.: 10/788,587  
Page 10

associated dependent claims 2-7 under 35 U.S.C. §102(b) or (e). As such, it is respectfully requested that this rejection be withdrawn.

#### IV. CLAIM REJECTIONS UNDER 35 U.S.C. §103(a)

##### A. Rejection of Claim 5

Claim 5 is rejected under 35 U.S.C. §103(a) as being obvious over *Johnson*. In view of the amendments to claim 1, from which claim 5 depends, it is believed that this rejection is obviated and should be withdrawn.

##### B. Rejection of Claims 8-22

Claims 8-22 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Johnson* in view of U.S. Patent No. 3,052,319 to Swanson ("*Swanson*"). Claims 8 and 9 depend directly or indirectly from claim 1. Claims 11-17 depend directly or indirectly from claim 10. Claims 19-22 depend directly or indirectly from claim 18. In view of the amendments to claim 1, 10, and 18, it is believed that this rejection is obviated and should be withdrawn.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference or combination of references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP §2142. It is submitted that for at least the following reasons, the combination of *Johnson* and *Swanson* is insufficient to make a *prima facie* case of obviousness.

##### 1. Claims 8 and 9

The amendments to claim 1 are discussed above. *Johnson* does not teach or suggest each and every element of amended claim 1. In particular, *Johnson* does not teach or suggest a nestable shopping cart formed to at least partially receive a second nestable shopping cart, where the nestable shopping cart includes a body comprising an integral seat portion and

Response to Office Action of April 7, 2006  
Application Serial No.: 10/788,587  
Page 11

back portion, where the back portion defines a nest space for receiving at least a portion of the second nestable shopping cart.

*Swanson* does not cure the deficiencies of *Johnson*. *Swanson* is directed to a cart and checkout counter assembly designed to facilitate checkout without having to remove the goods from cart. The cart of *Swanson* does not include an integral seat portion and back portion, the back portion defining a nest space for receiving at least a portion of a second nestable shopping cart. Instead, the nesting space of *Swanson* is created by moving or swinging gates 56 and 58 inwardly toward the basket.

Given that neither *Johnson* nor *Swanson*, nor the combination thereof, teaches or suggests all elements of the claimed invention, it is submitted respectfully that the combination of *Johnson* and *Swanson* is insufficient to support a rejection of claim 1 or its associated dependent claims 8 and 9 under 35 U.S.C. §103(a). As such, it is requested that this rejection be withdrawn.

2. Claims 10-17

*Johnson* does not teach or suggest a nestable shopping cart including a first basket and a second basket, as provided in amended claim 10. *Swanson* does not supplement the deficiencies of *Johnson*. Although the cart of *Swanson* includes a first basket and a second basket, the cart of *Swanson* does not include a first basket coupled to and extending from the frame of the cart and a second basket coupled to and extending from the frame above the first basket, where the first basket extends from the frame a greater distance than the second basket.

Given that neither *Johnson* nor *Swanson*, nor the combination thereof, teaches or suggests all elements of the claimed invention, it is submitted respectfully that the combination of *Johnson* and *Swanson* is insufficient to support a rejection of claim 10 or its associated dependent claims 11-17 under 35 U.S.C. §103(a). As such, it is requested that this rejection be withdrawn.

3. Claims 18-22

*Johnson* does not teach or suggest a nestable shopping cart including a first basket and a second basket, as provided in amended claim 18. Furthermore, *Johnson* does not teach or

Response to Office Action of April 7, 2006  
Application Serial No.: 10/788,587  
Page 12

suggest a nestable shopping cart including a cart passenger seat that faces the second basket, also as provided in amended claim 18. *Swanson* does not supplement the deficiencies of *Johnson*. *Swanson* does not teach or suggest a shopping cart including a passenger seat and, in particular, does not teach or suggest a shopping cart including a passenger seat that faces the second basket.

Given that neither *Johnson* nor *Swanson*, nor the combination thereof, teaches or suggests all elements of the claimed invention, it is submitted respectfully that the combination of *Johnson* and *Swanson* is insufficient to support a rejection of claim 18 or its associated dependent claims 19-22 under 35 U.S.C. §103(a). As such, it is requested that this rejection be withdrawn.

#### V. NEW CLAIMS

New claims 23-34 are presented by this Amendment. New claims 23-34 are believed to be allowable in that none of the cited references teach or suggest the nestable shopping cart presented therein.

Response to Office Action of April 7, 2006  
Application Serial No.: 10/788,587  
Page 13

### CONCLUSION

In view of the foregoing remarks, Applicant respectfully asserts that the rejection of the claims as set forth in the non-final Office Action of April 7, 2006 have been addressed and overcome. Applicant further respectfully asserts that all claims are in condition for allowance and request that a Notice of Allowance be issued. If issues may be resolved through Examiner's Amendment, or clarified in any manner, a call to the undersigned attorney at (404) 879-2437 is courteously solicited.

The Commissioner is hereby authorized to charge any fees due, or credit any overpayment, to Deposit Account No. 09-0528.

Respectfully submitted,



Dana E. Stano  
Registration No. 50,750

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Womble Carlyle Sandridge & Rice, PLLC  
P.O. Box 7037  
Atlanta, GA 30357-0037  
(404) 879-2437 (Telephone)  
(404) 879-2937 (Facsimile)  
Docket No.: R122 1020.3 (51939.0005.6)